



093306-024202

Exhibit 9 has been filed under seal under separate cover

IN THE UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

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GEN-PROBE INCORPORATED, )

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)

NO.99cv2668 H (AJB)

09:23:02

Plaintiff, )

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VS. )

09:23:02

)

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VYSIS, INC., )

09:23:02

)

8

Defendant. )

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CONFIDENTIAL

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Videotaped Deposition of

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JONATHON MICHAEL LAWRIE, Ph.D.

09:23:02

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Durham, North Carolina

09:23:02

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Thursday, February 15, 2001

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Reported by:

09:23:02

Sydney C. Silva, Registered Professional Reporter

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File No:

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Ex. 9 Pg. 45

202509060000

1 A. No. 14:34:16  
2 Q. Do you know whether there's any reference 14:34:17  
3 in the patent to a combination of target capture 14:34:19  
4 with a target-specific method of application -- of 14:34:25  
5 amplification? 14:34:26  
6 A. This patent here? 14:34:27  
7 Q. Yes. 14:34:29  
8 A. I haven't read it completely, just the 14:34:29  
9 pieces you have shown me. 14:34:32  
10 Q. When the patent application was filed, 14:34:34  
11 did you have any impression about whether the 14:34:36  
12 greatest degree of specificity sensitivity might be 14:34:38  
13 obtained by combining target capture with a 14:34:42  
14 target-specific method of amplification? 14:34:47  
15 A. I don't remember. 14:34:56  
16 Q. Does that stand to reason at all? 14:34:56  
17 A. I don't think so. I don't know what the 14:34:58  
18 thought process would have been back then. 14:35:00  
19 Q. Can you recall any reason that a 14:35:03  
20 reference to PCR might have been intentionally 14:35:05  
21 omitted from the patent application? 14:35:08  
22 A. Yes. 14:35:15  
23 Q. And what reason was that? Let me, let me 14:35:15  
24 start over. 14:35:23

Ex. 9 Pg. 46

20250708 09:56:50

1                   Was a reference to PCR intentionally                   14:35:24  
2 omitted from the patent to the best of your                   14:35:27  
3 understanding?                   14:35:29  
4           A.   I don't know.                   14:35:30  
5           Q.   Were there discussions about whether or                   14:35:31  
6 not to include a reference to PCR in the patent?                   14:35:32  
7           A.   I can't remember.                   14:35:36  
8           Q.   So at Amoco you had a thought about                   14:35:47  
9 combining target capture with PCR, is that right?                   14:35:51  
10          A.   Yes.                   14:35:54  
11          Q.   Gene-Trak then did work in an effort to                   14:35:55  
12 combine target capture with PCR, is that right?                   14:35:58  
13          A.   From seeing this here, yes.                   14:36:03  
14          Q.   Do you have a recollection of that?                   14:36:05  
15          A.   No.                   14:36:07  
16          Q.   If there's no reference in the patent to                   14:36:07  
17 combining target capture with PCR, do you have any                   14:36:09  
18 explanation as to why it is not there?                   14:36:13  
19          A.   I believe that it was a separate -- the                   14:36:15  
20 thought behind this was coming up with new methods                   14:36:17  
21 of amplification, not old ones.                   14:36:19  
22          Q.   And you would, for the purposes of what                   14:36:31  
23 you just said, you classify PCR as an old method of                   14:36:32  
24 amplification?                   14:36:36

Ex. 9 Pg. 47

902720-900000560

1 A. PCR itself was described in the patent, 14:36:37  
2 yes, issued patent. 14:36:40  
3 Q. And your understanding of the 338 patent 14:36:41  
4 was that it was directed to other methods of 14:36:44  
5 amplification? 14:36:47  
6 A. The, it was, it was directed to the 14:36:48  
7 methods disclosed by, you know, the methods 14:36:54  
8 separate from PCR. 14:36:59  
9 Q. Those being the methods, for example, as 14:37:07  
10 the methods set forth in Example 6 and 7? 14:37:10  
11 A. Yes. 14:37:14  
12 Q. Is it your understanding that the 338 14:37:20  
13 patent then doesn't encompass the combination of 14:37:22  
14 target capture and PCR? 14:37:28  
15 MR. BANKS: Object to the form. 14:37:30  
16 A. I couldn't say. 14:37:31  
17 Q. I'm sorry? 14:37:32  
18 A. I couldn't say. 14:37:32  
19 Q. Was it your intention that it encompass 14:37:33  
20 the combination of target capture and PCR? 14:37:38  
21 A. I don't know. I can't remember what the 14:37:40  
22 intention was in regards to PCR. 14:37:41  
23 Q. However, your recollection of why -- of 14:37:49  
24 if there's no -- your explanation of why there 14:37:50

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2025-09-09 09:00:00

1 might not be a reference to PCR in the patent is 14:37:53  
2 that the patent wasn't intended to cover old 14:37:56  
3 methods of amplification such as PCR; is that 14:38:03  
4 right? 14:38:06  
5 A. The patent was intended to cover the 14:38:07  
6 discoveries by myself, Halbert and King that there 14:38:09  
7 should be in some, you know, disclosure back at 14:38:15  
8 Amoco. That's what the patent was about. 14:38:16  
9 why PCR was left out I can just 14:38:22  
10 speculate. It wasn't what we came with, it was in 14:38:26  
11 the previous, it was a previous older method. 14:38:30  
12 Q. You were looking for other things? 14:38:33  
13 A. Yeah. 14:38:36  
14 MR. BOWEN: Let's assume that the patent 14:39:04  
15 application for the 330 patent was filed on 14:39:06  
16 December 21, 1987. Can we stipulate to that? 14:39:10  
17 MR. BANKS: For which patent? 14:39:16  
18 MR. BOWEN: The 330. 14:39:18  
19 MR. BANKS: The 330? Moving to a 14:39:20  
20 different one now? 14:39:21  
21 MR. BOWEN: I'm confused this late in the 14:39:22  
22 day, huh? The first application that claimed 14:39:25  
23 the combination of target capture and 14:39:27  
24 amplification. 14:39:32

Ex. 9 Pg. 49

0953909 02200

1 Example 5 is a linear method? 16:21:41  
2 A. Let's see. 16:21:44  
3 Yes, it is linear. 16:22:29  
4 Q. So Example 5 discloses a linear 16:22:31  
5 nonspecific method of amplification? 16:22:34  
6 A. Yes. 16:22:37  
7 Q. So recapping the examples, Examples 1 16:22:38  
8 through 3 disclose capture methods without 16:22:43  
9 amplification? 16:22:46  
10 A. Yes. 16:22:48  
11 Q. And Example 4 discloses linear 16:22:49  
12 nonspecific amplification? 16:22:53  
13 A. Yes. 16:22:54  
14 Q. Example 5 discloses linear nonspecific 16:22:55  
15 amplification? 16:22:59  
16 A. Yes. 16:23:00  
17 Q. Example 6 seeks to describe nonspecific 16:23:02  
18 exponential amplification? 16:23:10  
19 A. Let's see. Yes. 16:23:13  
20 Q. And Example 7 describes -- seeks to 16:23:18  
21 describe nonspecific exponential amplification? 16:23:22  
22 A. Yes. 16:23:28  
23 Q. Looking back at Column 30, specifically 16:23:44  
24 at Lines 30 through 40, which I think is two 16:23:48

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202720-906EE560